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EXAMINER

NATNAEL, PAULOS M

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 08/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/905,432

Applicant(s)

HAYES ET AL.

Examiner

Paulos M. Natnael

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2-9</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim **5** is rejected under 35 U.S.C. 102(e) as being anticipated by **Sato**, Japanese Patent No. **10282982**.

Considering claim **5**, **Sato** discloses all claimed subject matter, note;

a) a hand-held device having a display, is met by remote control 17, Fig.1;

b) a karaoke device having an application for reading song lyrics from a recorded media, wherein the hand-held device and the karaoke device are adapted to communicate such that the **karaoke** device can transmit signals indicative of the song lyrics to the handheld device and the hand-held device can display a representation of the song-lyrics in the display, is met by the Karaoke system Fig.1 which Karaoke system main body displays the lyrics on a remote control device having a second display. (see abstract)

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by **Fu**, U.S. Pat. No. **6,476,871**.

Considering claim 1, **Fu** discloses all claimed subject matter, note::

- a) a hand-held device having a display, is met by remote control 12, fig. 1;
- b) a consumer appliance having an application for reading closed captioning information from a video signal, is met by consumer electronics system 10, fig.1;
- c) wherein the hand-held device and the consumer appliance are adapted to communicate such that the consumer appliance can transmit signals indicative of the closed captioning information to the hand-held device and the hand-held device can display a representation of the closed captioning information in the display, is met by remote device 12 receives close captioning data from and system 10 and displays the data as shown in fig.1; (see col. 2, lines 29-65)

4. Claim **1-4, 16-29** are rejected under 35 U.S.C. 102(e) as being anticipated by Allport, U.S. Pat. No. **6,567,984**.

Considering claim 1, Allport discloses all claimed subject matter, note;

- a) a hand-held device having a display, is met by remote control unit 10, fig. 1;

b) a consumer appliance having an application for reading closed captioning information from a video signal, is met by base station unit 75, fig.2;

c) wherein the hand-held device and the consumer appliance are adapted to communicate such that the consumer appliance can transmit signals indicative of the closed captioning information to the hand-held device and the hand-held device can display a representation of the closed captioning information in the display, is met by the disclosure that "...One such situation is for users of TV systems that display text-based status information on the TV display during attribute adjustment (e.g., to volume, contrast, color, tint, brightness, sound, etc.), or for closed caption messages such as sports scores, stock quotes, etc. The remote control display may be used to display that information and therefore leave the primary viewing screen free of unnecessary clutter. For existing Internet-enabled TV the benefit realized is even greater due to the significant amount of screen real estate typically devoted to displaying navigational and other information. By adding a second display that communicates with the TV, all of the navigational interface can be removed from the TV screen, leaving much more room for actual viewing content.; (see col.4, lines 1-14)

Considering claim 2, the system as recited in claim 1, wherein the hand-held device comprises a memory for storing the closed captioning information and a program for replaying the stored closed captioning information, is met by memory 340, fig.4;

Considering claim 3, the system as recited in claim 1, wherein the closed captioning information is formatted using **a mark-up language** and the hand-held device comprises a browser application for displaying the closed captioning information in the display, is met by the disclosure that "...A data stream may be HTML data transmitted from the Internet, or it may be a "media stream" such as an analog or digital TV broadcast signal, satellite TV signal, cable TV signal, or other audio and/or video signal. Media streams such as TV broadcast signals may contain several channels, and each channel may further contain audio, video, or other embedded data streams, including HTML data. Furthermore, HTML data is used to refer to any Internet-derived data, as opposed to solely data that is in the HTML protocol format, as the concepts described herein are equally applicable to other Internet-derived data, especially data that is transmitted in a widely accepted Protocol; " (col. 1, lines 20-34) and that "For the situation where an Internet-enabled TV display is cluttered with text-based and other navigational information, a further benefit of the present invention is that with suitable HTML (Hypertext Markup Language) parsing software 10, some parts of the actual Internet content could also be displayed on the remote control's display 15." (col. 6, lines 50-65)

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Considering claim 4, the system as recited in claim 1, wherein the hand-held device comprises a remote control having a memory in which is stored command codes for commanding the operation of a plurality of different consumer appliances.

See rejection of claim 2.

Considering claim 16, in a consumer appliance, a method for displaying closed captioning information, comprising:

a) extracting the closed captioning information from a video signal, is met by base station unit 75, fig.2;

b) loading the extracted closed captioning information into a **mark-up language** page; and transmitting the mark-up language page to a device having a display, is met by the disclosure that is met by the disclosure that "...A data stream may be HTML data transmitted from the Internet, or it may be a "media stream" such as an analog or digital TV broadcast signal, satellite TV signal, cable TV signal, or other audio and/or video signal. Media streams such as TV broadcast signals may contain several channels, and each channel may further contain audio, video, or other embedded data streams, including HTML data. Furthermore, HTML data is used to refer to any Internet-derived data, as opposed to solely data that is in the HTML protocol format, as the concepts described herein are equally applicable to other Internet-derived data, especially data that is transmitted in a widely accepted Protocol;" (col. 1, lines 20-34) and that "For the situation where an Internet-enabled TV display is cluttered with text-based and other navigational information, a further benefit

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of the present invention is that with suitable HTML (Hypertext Markup Language) parsing software 10, some parts of the actual Internet content could also be displayed on the remote control's display 15." (col. 6, 50-65)

Considering claim 17, the method as recited in claim 16, further comprising the step of storing the extracted closed captioning information in memory and the steps of loading and transmitting are performed on a periodic basis.

See rejection of claim 2;

Considering claim 18, the method as recited in claim 16, wherein the steps of loading and transmitting are performed in response to a request received from the device having the display, is met by the disclosure that the HTML data sent to MUX 175 may be only part of the HTML data stream 85 and/or 95 originally entering the base station 75, as CPU 155 may first process data 85 and/or 95 and determine, based on requests from the remote control 10, that some of it should be passed to TV 80 instead. Col. 13, lines 31-45.

Considering claim 19, in a hand-held device having a display operable in connection with a consumer appliance having an application for reading closed captioning information from a video signal, a method for displaying information related to a viewed program, comprising:

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a) transmitting to the consumer appliance a request to receive information indicative of the closed captioning information, , is met by the disclosure that the HTML data sent to MUX 175 may be only part of the HTML data stream 85 and/or 95 originally entering the base station 75, as CPU 155 may first process data 85 and/or 95 and determine, based on requests from the remote control 10, that some of it should be passed to TV 80 instead." Col. 13, lines 31-45.

b) displaying received information indicative of the closed captioning information in the display,

Regarding b), see rejection of claim 1 (c) above.

Considering claim 20, the method as recited in claim 19, wherein the hand-held device comprises a browser application for displaying a mark-up language page received from the consumer appliance in which is placed the closed captioning information.

Regarding claim 20, See rejection of claim 3;

Considering claim 21, the method as recited in claim 19, further comprising the step of periodically requesting the consumer appliance to transmit the closed captioning information.

Regarding claim 21, See rejection of claim 19 (a).

Considering claim **22**, the method as recited in claim 19, further comprising the step of storing the closed captioning information and the step of displaying is performed in response to activation of a key associated with the hand-held device.

Regarding claims 2 and 22, See rejection of claim 19 (a).

Considering claim **23**, a readable media having instructions for displaying closed captioning information, the instructions performing steps comprising: extracting the closed captioning information from a video signal; loading the extracted closed captioning information into a mark-up language page; and transmitting the mark-up language page to a device having a display.

Regarding claim **23**, See rejection of claims 16 and 19.

Considering claim **24**, the readable media as recited in claim 23, wherein the instructions perform the further step comprising storing the extracted closed captioning information in memory and wherein the steps of loading and transmitting are performed on a periodic basis.

Regarding claim 24, See rejection of claim 2.

Considering claim **25**, the readable media as recited in claim 24, wherein the steps of loading and transmitting are performed in response to a request received from the device having the display.

Regarding claim 25, See rejection of claim 18.

Considering claim **26**, a readable media having instructions for displaying information related to a viewed gram, comprising: transmitting to a consumer appliance a request to receive information indicative closed captioning information; and displaying received information indicative of the closed captioning information in display of a hand-held device.

Regarding claim 26, see rejection of claim 19.

Considering claim **27**, the readable media as recited in claim 26, wherein the hand-held device comprises a browser application for displaying a mark-up language page received from the consumer appliance in which is placed the closed captioning information.

Regarding claim 27, see rejection of claim 3.

Considering claim **28**, the readable media as recited in claim 27, wherein the instructions further perform the step of periodically requesting the consumer appliance to transmit the closed captioning information.

Regarding claim 28, see rejection of claim 21.

Considering claim **29**, the readable media as recited in claim 27, wherein the instructions further perform the step of storing the closed captioning information and wherein the step of displaying is performed in response to activation of a key associated with the hand-held device.

Regarding claim 26, see rejection of claim 22.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims **2, 4, 6-15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Fu, U.S. Pat. No. 6,476,871.

Considering claim 2, the system as recited in claim 1, wherein the hand-held device comprises a memory for storing the closed captioning information and a program for replaying the stored closed captioning information, is inherent because the remote display.

Regarding claim 2, Fu does not specifically disclose whether the remote device 12 has memory. However, examiner takes official notice in that it is notoriously well

known in the art remote control device comprise storage for storing data including motion video, and therefore, it would have been obvious to those skilled in the art to modify the system of Fu to provide such a memory or storage for or codes such as for universal remote control could be stored in the memory of the remote device for easily controlling a variety of consumer appliances or devices, so that the user would be able to temporarily store the data for later play back.

Considering claim 4, the system as recited in claim 1, wherein the hand-held device comprises a remote control having a memory in which is stored command codes for commanding the operation of a plurality of different consumer appliances.

See rejection of claim 2.

Considering claim 6, a system, comprising:

a) a hand-held device having a display, is met by consumer electronics system 10, fig.1;
b) a consumer appliance having an application for reading **movie sub-titles** from a recorded media, is met by is met by consumer electronics system 10, fig.1, which may include VCR. (see col. 2, lines 29-65)

except for;

c) wherein the hand-held device and the consumer appliance are adapted to communicate such that the consumer appliance can transmit signals indicative of the movie sub-titles to the hand-held device and the hand--held device can display a representation of the movie sub-titles in the display.

Regarding c), Fu does not specifically disclose movie sub-titles. However, Fu disclose that the consumer electronics system includes a television receiver, which is well known in the art as a consumer electronics system that can display movie sub-titles. Therefore, examiner takes official notice in that it is notoriously well known in the art to display movie subtitles on a television receiver, and it would have been obvious to the skilled in the art to modify the system of Fu by providing subtitles in order to accommodate the hearing impaired or for the viewer who would like to read movie subtitles as well as watching the movie and that the hand-held device of Fu would be modified to display the said subtitles.

Considering claim 7, the system as recited in claim 6, wherein the recorded media is a digital video disc, is met by the disclosure that the consumer electronics system may include ...DVD player. (col. 2, lines 30-35)

Considering claim 8, a system, comprising:

a) a consumer appliance for playing a media, is met by consumer electronics system 10, fig.1;

b) a hand-held device having a display... adapted to display the readable representation of the audio track as the consumer appliance plays the media, is met by remote control 12, fig. 1;

Except for;

c) an associated memory storing a readable representation of an audio track of the media ;

Regarding c), see rejection of claim 2;

Considering claim 9, the system as recited in claim 8, wherein the media is a video program and the representation of the audio track comprises sub-titles, is met by the consumer electronics system 10 which displays text on remote device.

Considering claim 10, the system as recited in claim 9, wherein the consumer appliance is a digital video disc player, is met by the disclosure that "A consumer electronics system comprised of several components, which may include a television, a CD player, a tape deck, a VCR, a receiver, a DVD player, among other components. For purposes of this discussion, one component will be referred to as an audio device. col.2, lines 30-35.

Considering claim 11, the system as recited in claim 8, wherein the media is a compact disc and the representation of the audio track comprises song lyrics., is met by the disclosure that "A consumer electronics system comprised of several components, which may include a television, a CD player, a tape deck, a VCR, a receiver, a DVD player, among other components. For purposes of this discussion, one component will be referred to as an audio device. col.2, lines 30-35.

Considering claim **12**, the system as recited in claim 8. wherein the media is an audio broadcast and the consumer appliance is a radio receiver.

See rejection of claim 11.

Considering claim **13**, the system as recited in claim 8., further comprising a Web site from which the representation of the audio track is downloadable into the memory, is met by the disclosure on col. 3, lines 8-16 that one possibility for the consumer electronics system could be an Internet, or other networked, server located outside the home, of which the remote device is the only part of the system actually seen by the consumer. The server could download music via the Internet or other network and play both the audio signal and the closed-captioning display at the remote device. In this case, all parts of the apparatus necessary to perform this invention would be contained in the remote device

Considering claim **14**, the system as recited in claim 8, further comprising a kiosk from which the representation of the audio track is downloadable into the memory.

See rejection of claims 11 and 13.

Considering claim **15**, the system as recited in claim 8, wherein the memory comprises a removable smart card.

See rejection of claim 2;

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Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Grewe, U.S. Pat. No. **5,625,608** discloses a remote control device capable of downloading content information from an audio system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paulos M. Natnael whose telephone number is (703) 305-0019. The examiner can normally be reached on 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (703) 305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



PAULOS M. NATNAEL
PATENT EXAMINER

PMN
July 23, 2004